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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,214	11/12/2003	David Beckhardt	37942-1	6322

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Mitchell, Silberberg & Knupp, LLP
11377 West Olympic Boulevard
Los Angeles, CA 90064

EXAMINER

STEPHENSON, DANIEL P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/706,214	Applicant(s) BECKHARDT, DAVID	
	Examiner Daniel P Stephenson	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
4a) Of the above claim(s) 23-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-22, 46 and 47 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/12/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, 46 and 47, drawn to an apparatus for extraction including a gateway and a separator, classified in class 166, subclass 163.
 - II. Claims 35-39, drawn to an apparatus for extraction including a separator, classified in class 166, subclass 163.
 - III. Claims 23-34 and 40-45, drawn to a method for extracting material from a well, classified in class 166, subclass 311.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the separator is relied on only in a dependent claim and is therefore not relied on for patentability. The subcombination has separate utility such as a fluid purifier.
3. Inventions I or II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the

apparatus as claimed can be used to practice another and materially different process, specifically, it need not be used in a well, but could also be used in a pond/pool.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Joseph Swan on 3/4/05 a provisional election was made without traverse to prosecute the invention of group I, claims 1-22, 46 and 47. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5, 6, 8-22, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Bus in view of Heeter. Le Bus discloses an apparatus for extracting and transporting liquid or semi-liquid material. The apparatus has a container(3), an inlet/outlet (11) disposed beneath the container when the apparatus is in its operational orientation. The inlet allows material to enter and exit the apparatus. There is a gateway (14, 14a) disposed between the container and the inlet/outlet. The gateway is enclosed channel that has an interior surface. In tracing a pathway through the enclosed channel of the gateway, starting from the inlet/outlet

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side of the gateway and ending at the container side of the gateway the pathway first passes above a first point on the interior surface of the enclosed channel and then underneath a second point on the interior surface of the enclosed channel. The first point is higher than the second point with the apparatus in its operational position. Since the apparatus is used in a wellbore it is inherent that the inlet/outlet has a minimum dimension that is at least 1/4 inch-4 inches in length, depending on the size of the well. The gateway is disposed in close proximity with the inlet/outlet. The gateway comprises a rigid fitting. Another gateway is attached to the apparatus and is broadly interpreted to be a separator, located between the inlet and the gateway. The separator means has a vertically extending first tube (14) enclosed within a vertically extending second tube (7), wherein the first tube is open at its top, and wherein the second tube has a bottom surface (9) for collecting material that spills out of the top of the first tube. It is threaded onto the apparatus and therefore is readily detachable. Both tubes are broadly read as being flexible, since they are capable of being flexed. Le Bus does not show that there is a vacuum pump attached to the apparatus, nor that there is a flexible hose at least 50 ft in length attached to the apparatus. Heeter discloses a vacuum sand pump for use in a well. The sand pump has a flexible suction hose attached to an inlet apparatus from a vacuum source. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the flexible hose and vacuum source of Heeter in place of the submersible pump of Le Bus. This would be done because it is common knowledge in the pumping art that both a submersible pump and a vacuum pump provide a motive force for fluid and are functionally equivalent when placed above a fluid.

With regards to claims 8, 9, and 11, both apparatus are to be used in a wellbore, therefore it is inherent that they would be able to reach the production zone of the wellbore, which would involve a flexible hose at least 50 ft long.

8. Claims 1-3, 5, 6, 8-12, 17-22, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonner et al. in view of Heeter. Bonner et al. discloses an apparatus for extracting and transporting liquid or semi-liquid material. The apparatus has a container (2), an inlet/outlet (16) disposed beneath the container when the apparatus is in its operational orientation. The inlet allows material to enter and exit the apparatus. There is a gateway (19,20,21) disposed between the container and the inlet/outlet. The gateway is enclosed channel that has an interior surface. In tracing a pathway through the enclosed channel of the gateway, starting from the inlet/outlet side of the gateway and ending at the container side of the gateway the pathway first passes above a first point on the interior surface of the enclosed channel and then underneath a second point on the interior surface of the enclosed channel. The first point is higher than the second point with the apparatus in its operational position. Since the apparatus is used in a wellbore it is inherent that the inlet/outlet has a minimum dimension that is at least 1/4 inch-4 inches in length, depending on the size of the well. The gateway is disposed in close proximity with the inlet/outlet. The gateway comprises a rigid fitting. Bonner et al. does not show that there is a vacuum pump attached to the apparatus, nor that there is a flexible hose at least 50 ft in length attached to the apparatus. Heeter discloses a vacuum sand pump for use in a well. The sand pump has a flexible suction hose attached to an inlet apparatus from a vacuum source. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the flexible hose and vacuum source of Heeter in place of the reciprocating

pump of Bonner et al.. This would be done because it is common knowledge in the pumping art that both a reciprocating pump and a vacuum pump provide a motive force for fluid and are functionally equivalent when placed above a fluid.

With regards to claims 8, 9, and 11, both apparatus are to be used in a wellbore, therefore it is inherent that they would be able to reach the production zone of the wellbore, which would involve a flexible hose at least 50 ft long.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Le Bus or Bonner et al. in view of Heeter as applied to claim 1 above, and further in view of Goodman. Le Bus or Bonner et al. in view of Heeter shows all the limitations of the claimed invention, except, they do not show that there is a valve to control an opening between the container and ambient air.

Goodman discloses using a valve to change from a vacuum state to ambient or above air pressure to evacuate a container. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the setup of Goodman with the apparatus of Le Bus or Bonner et al. in view of Heeter. This would be done to allow for evacuation of the fluid easily.

Allowable Subject Matter

10. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Varner, Abrams, Henry, Sorhus et al. and Strickland all show similar elements to those of the present invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P Stephenson whose telephone number is (571) 272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

DPS 